

## REMARKS/ARGUMENTS

Claims 1-6, 8, 10-14, 16-22, and 25-40 are pending in the present application and remain in this application for prosecution. Claims 1, 8, 14, 19, 27, and 32 have been currently amended.

### § 103 Rejections

**Claims 1-6, 14, 16-21, 25-33, 36, 37, and 40** have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 5,842,698 to Brown ("Brown") in view of U.S. Patent No. 6,517,073 to Vancura ("Vancura") and U. S. Patent No. 7,169,041 to Tessmer ("Tessmer") *et al.* **Claims 8, 10-13, 34, and 35** have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Brown in view of Vancura and Tessmer and further in view of U.S. Patent No. 6,155,925 to Giobbi ("Giobbi"). **Claims 22, 38, and 39** have been rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Brown in view of Vancura and Tessmer, and further in view of U.S. Patent No. 6,210,275 to Olsen.

#### A. Brown, Vancura, and Tessmer Fail To Disclose Player Participation In Selecting A Side Wager Event

**Claims 1, 8, 14, 19, 27, and 32** (*i.e.*, all the independent claims) have been amended to clarify that the event, on which the side wager is made, is selected by a player from a plurality of events. For example, claim 1 has been amended to clarify that "the non-eligible player ha[s] a selection choice to select the event from a plurality of events." Similar amendments have been made to claims 8, 14, 19, 27, and 32. None of the cited references teaches that a side-wagering player can select the event on which the side wager is being made.

The office action clearly acknowledges that “Brown is silent regarding ... Non-eligible players being able to make side wagers in the bonus game.” Similarly, Tessmer fails to teach this claim element. Tessmer is generally directed to a method for weighting odds to specific gaming entities, and it was cited for supporting an allegation that it discloses “play of networked gaming machines.” However, the office action does not allege anywhere that Tessmer teaches anything related to a side wager. As explained in more detail below, Vancura (which is the only reference relied on by the office action for showing a side wager) also fails to teach this claim element.

The office action alleges that Vancura teaches “the option of allowing non-eligible players to participate in their own way . . . through the offering of a side wager (6:54-67).” However, except for a player making a side wager, the side wagers of Vancura fail to include player participation in selecting the event on which the side wager is being made.

In the portion of Vancura cited to by the office action, Vancura refers to a “Good Samaritan” or “bystanders’ bonus” feature, “which all players receive when someone lands in jail.” Vancura, col. 6, ll. 30-32 (emphasis added). The side wagering players do not have a choice in selecting the event that awards the bystanders’ bonus. The event, *i.e.*, “when someone lands in jail,” is an already-set event that fails to involve player participation. The side wagering players are, literally, “bystanders.”

Other references to side wagering in Vancura also fail to disclose a non-eligible player’s participation in selecting the event on which the side wager is being made. For example, in the Abstract, Vancura discloses that “[s]ide wagers allow bettors to win of [sic] the bonus with random selection.” Vancura, Abstract. Clearly, the “random selection” of the bonus does not involve player input in selecting the bonus.

Additionally, the side wagering examples identified by Vancura in the Background Of The Invention section also fail to disclose participation of a non-eligible player by selecting an event from a plurality of events. For example, the “Over/Under 13 wager” example refers to a side bet in which the same player bets “on whether the player’s first two cards will total over or total below 13.” Vancura, col. 1, ll. 42-43. The Over/Under example requires the same player to make the side bet (in contrast to having a non-eligible player making the side wager). Moreover, the Over/Under example fails to explicitly disclose that the player has a choice for selecting “Over” or “Under.” Similarly, the “Royal Match” example requires for the same player to place the “side bet on whether the player’s first two cards will be of the same suit.” The “Royal Match” example also fails to disclose that the player can select a particular event from a plurality of events, *i.e.*, the event is an already selected event – selecting first two cards to be of the same suit - over which the player has no input.

Thus, the Applicants respectfully submit that the claims are patentable over Brown, Vancura, and Tessmer, at least because none of the references discloses participation by a player in selecting the event, from a plurality of events, on which the side wager is being made.

#### B. Vancura Fails To Disclose Prediction Regarding Landing Of A Game Piece

Claim 26 and 31 are directed to the side wager being a “prediction whether a player will land a game piece on a certain location of a board game.” The office action acknowledges that Brown is “silent” regarding this claim element, but alleges that Vancura “teaches the use of a gameboard (feature 12) and associated predictions as a bonus game.” Vancura fails to teach this claim element.

As explained above in reference to the independent claims, Vancura’s side wager fails to involve the side-wagering player as a participant in selecting the particular event on which the

side wager is being made. For example, referring to the "bystander's bonus" (in which other players are paid when a player lands on a "Go To Jail" square), none of the players are allowed to make any predictions that one of the players may land on the "Go To Jail" square. The event of landing on the "Go To Jail" square has nothing to do with any player predictions.

Thus, the Applicants respectfully submit that claims 26 and 31 are patentable over the cited references at least for the above stated reason.

### Conclusion

It is the Applicants' belief that all the pending claims are now in condition for allowance, and thus reconsideration of this application is respectfully requested. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

A check of \$930 is enclosed to cover the fees associated with the one-month extension of time and the Request for Continued Examination. It is believed that no additional fee is presently due. However, should any additional fees be required, the Commissioner is authorized to deduct the fees (except for payment of the issue fee) from Nixon Peabody LLP Deposit Account No. 50-4181, Order No. 247079-000207USPT.

Respectfully submitted,

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